

REMARKS

The Official Action dated August 26, 1987 has been carefully reviewed. Claims 1-30 are presented for examination. Claims 1-30 are rejected. No claims stand allowed.

Claims 7-24 are provisionally rejected under 35 USC 101 as claiming the same invention as that of claims 7-24 of co-pending application Serial No. 867,996. Claims 1-6 and 25-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 and 25 of co-pending application Serial No. 867,996. Both rejections are provisional double patenting rejections. There is being submitted herewith a Terminal Disclaimer signed by the assignee of the instant application. Since the conflicting application is commonly owned with the present application, it is believed that the submission of the Terminal Disclaimer will overcome the double patenting rejections.

The specification is objected to under 35 USC 112 first paragraph as failing to provide an adequate written description of the invention. The term "lower alkyl carboxy" is held to be a distortion (In re Hill, 73 USPQ 482) and that the term should read "carboxy lower alkyl". It is submitted that the term "lower alkoxy carbonyl" is not a distortion in the sense in which the term is used in In re Hill, cited by the Examiner. The chemical symbol intended is clear whether the words lower alkyl come before or after carboxy.

Claims 1-4 and 19-25 are rejected under 35 U.S.C. 112, first and second paragraphs, for failing to describe the invention in such clear, full, concise and exact terms as to enable one skilled in the art to make and use same and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner has concluded that the use of the term "substituted" without a recitation of the substituents renders the claim indefinite and otherwise not adequately supported by the enabling disclosure. By the present amendment claim 1 is being amended to include the particular substituents contemplated. Support for this amendment is found on pages 9 and 10 of the specification.

The Examiner objects to use of the following groups: "alkanoyloxy" because it encompasses "acetox"; $-C(O)-R_5$ where R_5 is "alkyl" because it encompasses "lower alkyl carbonyl", "acyloxy" because it encompasses "alkanoate" "acyl" and $-C(O)R_{14}$. In addition R_6 and R_7 , as "hydrogen" and "alkyl" is recited twice. By the present amendment claim 1 is being amended by the deletion of the terms "alkanoyloxy", "lower alkyl carbonyl" and "alkanoate", the repeated portion of the definition of R_6 and R_7 is also being deleted.

The terms "acyl" and "acyloxy" are objected to as being indefinite and otherwise not adequately supported by the specification. The terms are thought to read on any organic acid residue and are ordinarily construed to include more than carboxylic acid residues. By the present amendment claim 1 is being amended by deleting the terms "acyl" and "acyloxy" and substituting in place of "acyloxy" the term "lower alkanoyloxy".

having 1-6 carbon atoms". Support for the carbon-carbon limitation is found on page 6, line 19 and page 8, lines 15-18 of the specification.

The term "lower alkyl carboxy" is being deleted in claim 1 and is being replaced by the term "carboxy lower alkyl".

The recitation of the words "such as" in the claims is objected to as rendering the claims indefinite. By the present amendment the words "such as" are being deleted from the claims.

The terms "alkyl" and "cycloalkyl" are objected to for not reciting carbon atom ranges. By the present amendment the word alkyl is being replaced with the term lower alkyl. The new term is defined on page 10 of the specification. The term cycloalkyl is being deleted by the present amendment. The words "hetrocyclic ring such as" are also being deleted by the present amendment.

The composition claims are objected to for failing to recite a specific intended use. By the present amendment the composition claims are being amended by the insertion of the specific use. The Examiner has also indicated that the composition claims should recite the amount of the active ingredient and deems the phrase "an effective amount" too broad. The case cited by the Examiner in support of his conclusion does not require the recitation of the amount of the active ingredient in a composition. The case merely stands for the proposition that the claims are too broad and indefinite in the designation of an amount of dimethyl sulfoxide as "an effective amount" or "an effective amount up to 50%" without

designating the intended effect. Applicants have inserted the intended effect into the claims by this amendment. The specification teaches the proportions which are suitable for the claimed compositions. It is submitted that, in the absence of art which would limit Applicants to any particular proportions, it is assumed that the claims cover operative conditions. Therefore, it is sufficient for the purpose of 35 U.S.C. 112 to recite "an effective" amount in the claims without specifying the actual amount of the active ingredient.

Reconsideration of the rejection of claims 1-4 and 19-25 under 35 U.S.C. 112 is courteously requested.

Claims 1-6, 8, 13, 14 and 19-24 are rejected under 35 U.S.C. 103 as being unpatentable over U.S. Patent No. 4,095,025 (Newberry). The Examiner has pointed out that at column 2, line 10, formula VII of the patent, 1,5-diarylpyrazoles wherein the 3-position is substituted by an aliphatic acid radical are disclosed in generic form. The compounds are said to be anti-inflammatory agents.

Although the 1,5-diarylpyrazoles are generically disclosed in the patent, the only compounds actually disclosed in the patent are 1,3-diarylpyrazole-4-acrylic acids and their derivatives. There is no disclosure of specific 1,5-diaryl-3-substituted pyrazoles in the patent. Although the generic structure disclosed in the patent has an aliphatic acid or aliphatic acid radical or derivative thereof in the 3-position, it does not follow that any aliphatic acid derivative would be obvious over the generic disclosure.

Therefore, Applicants have amended claim 1 by deleting from the Markush group those substituents which could be said to be obvious in view of the generic disclosure. Obviously Applicant is entitled to claim those compounds which are not obvious over the generic disclosure. Although Applicants have deleted certain substituents from the Markush group, it is submitted that the cancellation of members from a Markush claim does not create a new sub-genus which had to be expressly disclosed in order to meet the requirements of 35 U.S.C. 112 or to avoid the prohibition of 35 U.S.C. 112. Ex parte Hughes (POBA 1978) 377 PTCJ A-9 and In re Johnson et al. (CCPA 1977) 194 U.S.P.Q. 187. Reconsideration of the rejection of claims 1-6, 8, 13, 14 and 19-24 under 35 USC 103 is courteously requested.

Claims 1-6, 8, 13, 14 and 19-24 are rejected under 35 USC 103 as being unpatentable over Rainer (U.S. Patent No. 3,974,176). Rainer discloses 1, 3-diaryl-5-halopyrazole-4-acetic acids and their derivatives. As pointed out by the Examiner, the Rainer compounds differ from the claimed compounds. The Rainer compounds are 1,3-diarylpyrazoles having a halogen in the 3-position and an acetic acid residue in the 5-position. Applicant's compounds on the other hand are 1, 5-diarylpyrazoles having a substituted hydrocarbon in the 3-position and a substituent in the 4-position when y is other than hydrogen. It is an over simplification to say that the instant compounds are position isomers of the cited compounds, particularly in view of the fact that the substituent in the instant compounds is in the 3-position while the substituent in the reference compounds is in the 5-position. The fact that 1,3-diarylpyrazoles are known in the art does not make obvious 1,5-diarylpyrazoles which are totally different compounds. To

be obvious over the cited compounds the method of preparing the instant compounds most also be obvious in view of the reference. In the cited patent, the 1,3-diaryl-5-halo-pyrazoles are prepared from 1,3-diaryl-5-chloro-pyrazoles. There is no disclosure in the reference of a method by which one skilled in the art can prepare applicants' 1,5-diaryl-3-substituted pyrazoles. The fact that the compounds have some similar utilities does not in and of itself make the compounds obvious in view of each other. It is submitted that applicants' 1,5-diaryl-3-substituted pyrazoles are not obvious in view of the disclosure in the reference of 1,3-diaryl-5-chloro-pyrazoles.

Claim 25 is rejected under 35 U.S.C. 103 as being unpatentable over Newberry under 35 U.S.C. 103. By the present amendment claim 25 is being cancelled. Further discussion of the rejection of claim 25, therefore, is not deemed necessary.

The multiple dependency being introduced into claims 19 and 23 by this amendment is believed to be proper in view of MPEP 608.01(n).

Pursuant to the Examiner's request, a copy of each of the references listed in the "Background" section of the specification is enclosed.

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In view of the above discussion and the amendments herein being made to the claims, it is believed that all of the outstanding rejections and objections have been removed. A favorable disposition of the application is courteously requested.

Respectfully submitted,

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